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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,087	04/24/2006	Henrik Przybilla	AT03 0059 US1	1182
65913	7590	09/17/2009	EXAMINER	
NXP, B.V. NXP INTELLECTUAL PROPERTY & LICENSING M/S41-SJ 1109 MCKAY DRIVE SAN JOSE, CA 95131			NIGH, JAMES D	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			09/17/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ip.department.us@nxp.com

Office Action Summary	Application No. 10/577,087	Applicant(s) PRZEBILLA, HENRIK	
	Examiner JAMES D. NIGH	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>24 April 2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to application filed on 24 April 2006. Claims 1-10 are presented for examination on the merits.

Priority

2. Receipt is acknowledged of papers submitted 24 April 2006 under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) was submitted on 24 April 2006. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
6. Claim 1 recites a DRM user unit which is comprised of an authentication unit and a rights storage unit. In the broadest reasonable interpretation a unit is not positively associated with a Process, Machine, Manufacture, Composition of Matter and therefore the claim does not comprise eligible subject matter and appears to be software *per se*. See "Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility", issued 24 August 2009. The rejection may be overcome by positively reciting physical structure as part of the DRM user unit.

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7. Claims 2-7 are also rejected as being dependent upon claim 1.

8. Claim 8 recites a DRM client unit which is comprised of a data storage unit, an authentication unit and a rights interface. In the broadest reasonable interpretation neither a unit nor an interface is positively associated with a Process, Machine, Manufacture, Composition of Matter and therefore the claim does not comprise eligible subject matter and appears to be software *per se*. See "Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility", issued 24 August 2009. The rejection may be overcome by positively reciting physical structure as part of the DRM client unit.

9. Claim 9 recites a system comprised of entirely of units. In the broadest reasonable interpretation a unit is not positively associated with a Process, Machine, Manufacture, Composition of Matter and therefore the claim does not comprise eligible subject matter and appears to be software *per se*. See "Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility", issued 24 August 2009. The rejection may be overcome by positively reciting physical structure as part of the claim, such as a server or a device.

10. Claim 10 recites a method but does not require that the method be implemented by a particular machine, nor does the claim particularly transform a particular article; therefore the method is not eligible under 35 U.S.C. § 101. See "Interim Examination Instructions for Evaluating Patent Subject Matter Eligibility", issued 24 August 2009. The rejection may be overcome by positively reciting within the claim limitations the physical structure that is performing the method steps.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 1 recites a DRM user unit comprised of an authentication unit and a rights storage unit. As the claim appears to be directed towards a device the recitation of claim elements which in the broadest reasonable interpretation may be comprised entirely of software makes the scope of the claim unclear and is therefore indefinite “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...”, *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)

14. Claims 2-7 are also rejected as being part of claim 1.

15. Claim 8 recites a digital rights management client unit comprised of a data storage unit, an authentication unit and a rights interface. As the claim appears to be directed towards a device the recitation of claim elements which in the broadest reasonable interpretation may be comprised entirely of software makes the scope of the claim unclear and is therefore indefinite “An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...”, *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)

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16. Claim 9 recites a digital rights management system comprised of DRM client units, DRM server units, DRM user units, an authentication unit and a rights storage unit. As the claim appears to be directed towards a system the recitation of claim elements which in the broadest reasonable interpretation may be comprised entirely of software makes the scope of the claim unclear and is therefore indefinite "An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed...", *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

18. **Claims 1-2 and 4-9 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Messerges et al. (U.S. Patent PG Publication 2004/0103312, hereinafter referred to as Messerges).**

19. As per claim 1

Messerges discloses an authentication unit for authentication of the DRM user unit to a DRM server unit and for authentication of a DRM client unit to the DRM user unit (0017-0021, 0024-0026, 0033-0035)

Messerges discloses a rights storage unit for storing digital rights objects received from a DRM server unit (0030, 0035)

Messerges discloses wherein said digital rights objects can be accessed by an authenticated DRM client unit to get usage rights for the usage of an associated digital

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data object stored on said DRM client unit (Abstract, 0009, 0021); additionally this recitation is simply descriptive material and as the claimed data has no manipulative effect on any of the structure it is nonfunctional in nature and therefore is not entitled to any patentable weight “Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability [T]he critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate” *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II, “We conclude that when the prior art describes all of the claimed structural and functional relationships between descriptive material and the substrate, but the prior art describes a different descriptive material than the claim, then the claimed descriptive material is non-functional and will not constitute a sufficient difference from the prior art to establish patentability”, *Ex parte Halligan*, 89 USPQ2d 1355 (Bd. Pat. App. & Int. 2008). The language following the wherein statement “can be accessed by an authenticated DRM client unit to get usage rights for the usage of an associated digital data object stored on said DRM client unit” is also optional language; simply because a rights object “can” be accessed does not mean that it will be accessed and therefore may never happen. See MPEP § 2106 II C.

20. As per claim 2

Messerges discloses a rights interface unit for receiving digital rights objects from a DRM server unit (0021)

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Messerges discloses to which the DRM user has authenticated (0021); additionally this is intended use.

Messerges discloses granting usage rights for the use of a digital data object stored on an authenticated DRM client unit (0021, 0024, 0026, 0031)

Messerges discloses “and associated with a digital rights object stored in said rights storage unit” (0030, 0035), additionally this is non-functional descriptive material

21. As per claim 4

Messerges discloses wherein said DRM user unit is a portable electronic device, in particular a smart card, a PCMCIA card or a mobile terminal, such as a mobile audio and/or video player, a mobile phone or a PDA (0010, 0018, 0030).

22. As per claim 5

Messerges discloses “wherein said digital rights objects include an access information which DRM client units shall get access to a digital rights objects, said access information being checked by the DRM user unit after authentication of a DRM client requesting access to said digital rights object” (0032-0035); additionally this is non-functional descriptive material.

23. As per claim 6

Messerges discloses a portable memory unit for storing at least part of the digital rights objects or a copy of the digital rights objects stored in said rights storage unit (0030)

While Messerges does not explicitly disclose “the presence of said portable memory unit being checked before an access to digital rights objects is granted”,

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Messerges teaches a wireless identity module (WIM) and/or smart card (0030). As the keys necessary for authentication would be stored in these modules it would be inherent that the unit be checked for its presence simply by the act of requesting the keys. Additionally this is intended use.

24. As per claim 7

“wherein said digital rights objects include an transfer indicator indicating if a digital rights object is transferable to all DRM client units or not” is not explicitly disclosed by Messerges; however as Messerges discloses validation of the second device (0034) when trying to join the domain a predictable result (*KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007)) of Messerges would be for the issuer simply to refuse to register the second device. Moreover this is non-functional descriptive material.

Messerges discloses wherein said authentication unit is adapted for authenticating the DRM client unit requesting access (0031-0035).

“to a non-transferable digital rights object to the DRM server unit” is simply intended use.

25. As per claim 8

Messerges discloses a data storage unit for storing digital rights (0030, 0035)

Messerges discloses an authentication unit for authentication of a DRM client unit to the DRM user unit (0017-0021, 0024-0026, 0033-0035)

Messerges discloses a rights interface unit for requesting access to a digital rights object associated with a digital data object stored in said data storage unit (0021)

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Messerges discloses “after authentication to a DRM user unit to get usage rights for the usage of said associated digital data object” (0021); moreover this is intended use.

26. As per claim 9

Messerges discloses DRM client units for storing digital data objects (0009)

Messerges discloses DRM server units for issuing digital rights objects representing usage rights of associated digital data objects (Abstract, 0017-0021, 0024-0026, 0033-0035).

Messerges discloses an authentication unit for authentication of the DRM user unit to a DRM server unit and for authentication of a DRM client unit to the DRM user unit (0017-0021, 0024-0026, 0033-0035)

Messerges discloses a rights storage unit for storing digital rights objects received from a DRM server unit (0030, 0035)

Messerges discloses “wherein said digital rights objects can be accessed by an authenticated DRM client unit to get usage rights for the usage of an associated digital data object stored on said DRM client unit” (Abstract, 0009, 0021); moreover this is non-functional descriptive material.

Claim Rejections - 35 USC § 103

27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

28. **Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges in view of RFC2459 (RFC2459, Internet X.509 Public Key Infrastructure Certificate and CRL Profile, January 1999, 110 pages, hereinafter referred to as RFC2459).**

29. As per claim 3

Messerges, while disclosing revocation (0027) does not explicitly disclose a revocation list storage unit for storing a revocation list of DRM client units, said revocation list being checked by said authentication unit during authentication of a DRM client unit. However Messerges does teach X.509 certificates in paragraph 0014. RFC2459, the document defining the X.509 certificate, explicitly teaches a revocation list (Abstract, 3.3) and that the list is checked during authentication (3.3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the domain based digital rights management system with easy and secure device enrollment of Messerges with the X.509 infrastructure of RFC2459 for the purpose of processing certification paths in the Internet.

30. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Messerges.**

31. As per claim 10

Messerges discloses an authentication unit for authentication of the DRM user unit to a DRM server unit and for authentication of a DRM client unit to the DRM user unit (0017-0021, 0024-0026, 0033-0035)

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Messerges discloses a rights storage unit for storing digital rights objects received from a DRM server unit (0030, 0035)

Messerges does not explicitly disclose transfer of usage rights from said DRM user unit to said DRM client unit after successful authentication. Messerges teaches that usage rights may be extended from a first device to a second device via enrollment in a domain (0031-0035)

for the usage of an associated digital data object stored on said DRM client unit is a statement of intended use; however this is taught by Messerges (0031-0035).

Please note:

A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant(s) are reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C: “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. [Emphasis in original.]”; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) (“As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.”).

Conclusion

Pertinent Art Not Cited

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32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Wireless Identity Module Part: Security Version, 12-July-2001, Wireless Application Protocol WAP-260-WIM-20010712-a, Wireless Application Protocol Forum, Ltd., 105 pages.

Inquiries Regarding Communications

33. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES D. NIGH whose telephone number is (571)270-5486. The examiner can normally be reached on Monday-Thursday 6:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JAMES D NIGH/

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Examiner, Art Unit 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685